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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,662	09/29/2003	Jeffrey S. Swayze	ENDS131.0517373	2356

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FROST BROWN TODD LLC
2200 PNC Center
201 E. Fifth Street
Cincinnati, OH 45202-4182

EXAMINER

NASH, BRIAN D

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/673,662	SWAYZE ET AL.	
	Examiner	Art Unit	
	Brian Nash	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-19 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examiner's Comments

1. This action is in response to applicant's amendment received 2/16/2005. Applicant has amended claims 5, 7-8, 10-11, 14-16, and 19 and in doing so has remedied all objections to the claims and all rejections made under the second paragraph of 35 U.S.C. 112.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-10, 12-13, 15, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,465,895 to Knodel et al. Knodel et al show the same invention, a surgical apparatus having an end effector (see Fig. 1, not referenced), a shaft (152), a firing member (160,162), a handle (130), a firing control (140), a closure means (150) with an arcuate surface (150b, Fig. 3), a firing mechanism coupled with the firing member (see column 8, lines 29-46); wherein the end effector has an elongate channel (112), a pivotally coupled anvil (114), and a staple cartridge (120). Knodel et al further show a rack (164,182) movably coupled (via 170) with the firing member and the firing mechanism.

4. Claims 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,762,256 to Mastri et al. Mastri et al show the same invention, a surgical apparatus having an end effector (see Fig. 1, not referenced), a shaft (14) connected thereto and a firing member (64) received by

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the shaft, a handle (12), a rack (42), a firing control (26), and a firing mechanism (40) including a pawl (44); wherein the end effector has a stapling device (30), an elongate channel (110), a pivotally coupled anvil (36), and a staple cartridge (34).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,465,895 to Knodel et al. As discussed above in this office action, Knodel et al show the same invention substantially as claimed, but do not mention an elastomeric material or a material having a coefficient of friction between 0.04 and 0.4 used for one of the biasing surfaces. It would have been an obvious matter of design choice to have incorporated either material choice for one of the biasing surfaces since elastomers and materials having varying coefficients of friction are both well known in the art and applicant has not disclosed that either material solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with either design choice as evidenced by the apparatus of Knodel et al.

Response to Arguments

7. *In re* claims 1-10, 12-13, 15, and 19 applicant's arguments filed 9 December 2004 have been fully considered but they are not persuasive. Applicant contends, *inter alia*, that US

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5,465,895 to Knodel et al (hereinafter US '895) does not perform the same function as the claimed invention. Specifically, applicant contends that the firing mechanism of US '895 does not teach a "frictionally biased" firing mechanism. Examiner acknowledges applicant's position; however, a reference is deemed to properly anticipate a claim when all the recited limitations are disclosed therein.

In this instance, US '895 clearly shows all the recited structural limitations including a firing mechanism that is frictionally biased to couple with the firing member (160,162) (US '895, column 8, lines 29-46). While it is noted that the device of US '895 may not perform the same function in the same manner as applicant's invention, it is deemed that the claims are not restrictive to such device.

The terminology "frictionally biased" is not specifically defined or given any unexpected definition in the specifications. The examiner construes "frictional bias" to encompass any two or more components that come into contact with each other since the force of friction between components is always present. The applicant states that the firing mechanism of US '895 includes gear 170a, member 180 and gear 170b and is permanently coupled to the firing member by engagement of gear 170a with drive member 164 (see remarks, page 7). Therefore, US '895 clearly shows the firing mechanism to be frictionally biased and coupled with the firing member. Similarly regarding claim 19, US '895 clearly shows a firing means frictionally coupling the firing motion of the firing actuator to the end effector since all components are in physical, i.e. frictional, contact with each other.

8. *In re* claims 16-19 applicant's arguments filed 9 December 2004 have been fully considered but they are not persuasive. Applicant contends, *inter alia*, that US 5,762,256 to

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Mastri et al (hereinafter US '256) does not perform the same function as the claimed invention.

Specifically, applicant contends that pawl (44) of US '256 is not frictionally biased to communicate motion of the firing actuator to the firing member. Examiner acknowledges applicant's position; however, a reference is deemed to properly anticipate a claim when all the recited limitations are disclosed therein.

In this instance, US '256 clearly shows all the recited structural limitations including a firing mechanism (40) having a frictionally biased pawl (44) adapted to couple the firing control (26) to the rack (42) imparting the firing motion in response to movement of the firing control (see US '256, column 7, lines 1-20). While it is noted that the device of US '256 may not perform the same function in the same manner as applicant's invention, it is deemed that the claims are not restrictive to such device.

For the reasons above, the grounds for rejection are deemed proper.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Nash whose telephone number is 571-272-4465. The examiner can normally be reached on Monday – Thursday from 8 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached at 571-272-4467.

The official fax number for this Group is: 703-872-9306

Brian Nash
11 March 2005



Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700